

REMARKS

Claims 2-9 and 12 are pending.

Claims 2-9 and 12 are rejected.

35 USC 112, First Paragraph

Claims 1-9 and 12 are rejected under 35 USC 112, first paragraph.

The examiner states that the specification does not adequately describe all the species included within the claims in such as a way as to make and or/use the invention.

Examiner refers specifically to the definitions of A and B.

Applicants have amended A to include the substituted and unsubstituted radicals defined on page 11 through last paragraph of page 12, as well as those radicals contained in Table 1, page 33, No. II-1 and page 35, No. VI of the present specification.

The Examiner states that moiety B is exemplified by only **-NH-CO-**. Applicants refer the Examiner to Table I and alternative B moieties, such as

Nos. III-1 to III-5, page 34	-CO-NH-
Nos. IV-1 and IV-2, page 35	-NH-CO-NH-
No. VI, page 35	-NH-CO- and -O-CO-
No. VII, page 36	-NH-CO and -CO-O-
and No. VIII, page 36	-NH-CO-NH- and -CO-NH-

The Applicants refer to ***Amgen Inc. v. Chugai Pharm. Co.***, 927 F.2d 1200, 18 USPQ 2d 1016, 1027 (Fed. Cir.), ***cert. denied***, 502 U.S. 856 (1991)

It is well established that a patent applicant is entitled to claim his invention generically, when he describes it sufficiently to meet the requirements of Section 112. See *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ 2d 1709, 1714 (Fed. Cir. 1988) ("A specification may, within the meaning of 35 U.S.C. § 112 ¶1, contain a written description of a broadly claimed invention without describing all species that claim encompasses."); *In re Robins*, 429 F.2d 452, 456-57,

166 USPQ 552, 555 (C.C.P.A. 1970) ("[R]epresentative samples are not required by the statute and are not an end in themselves.").

It is also well established *In re Fisher*, 166 USPQ 18, 24 (C.C.P.A. 1970)

It is apparent that such an inventor should be allowed to dominate the future patentable inventions of others where those inventions were based in some way on his teachings, are still within his contribution, since the improvement was made possible by his work....

One skilled in the art would expect substitution by an esters, thioester, ethers, thioethers, ketones, secondary and tertiary amines, imides, imines, azo, azoxy, ureas, urethanes, thiourethanes and sulfonamides to function similarly as the amide. All would be capable of forming one or more intermolecular hydrogen bonds.

All could be made similarly as in the disclosed examples. For instance, in Example A wherein an acid chloride (3,4-bis(octyloxy)benzoic acid chloride) is reacted with an amine (tris(4-aminophenylene)amine), one skilled in the art might replace the amine with an hydroxyl to arrive at the ester or replace the acid chloride with a thionyl chloride to produce a thioester. Functional linkages covering the other B groups are well known and methods for making them by those skilled in the art. Thus the Applicants aver that to restrict B to amides only is improper as this would allow others to use the improvement made possible by the Applicants but circumvent the claimed invention.

Reconsideration and withdrawal of the rejection of claims 2-9 and 12 is respectfully solicited in light of the remarks and amendments *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 2-9 and 12 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Shiela A. Loggins
Agent for Applicants
Reg. No. 56, 221

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-2768
Enclosure: Petition for one (1) extension.

SAL\22531.doc